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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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John Roger Sampson

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EXAMINER

NGUYEN, PHU HOANG

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/590,689	<b>Applicant(s)</b> SAMPSON ET AL.	
	<b>Examiner</b> PHU H. NGUYEN	<b>Art Unit</b> 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) 46-53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the sixth paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Claim 32 recites "a means for supplying a web material" is a means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. The written description in specification of the instant application links the means to a structure such as a mandrel (paragraph 65).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gentry (U.S Patent No. 5131416) in view of Crooks et al. (U.S Pub. No. 20020185143).

Regarding claim 1, Gentry discloses a smoking article comprising a rod of smokable material (20, fig. 1), a wrapper (27, fig. 1) about said rod of smokable material and a web material (25, fig. 1) comprising an adsorbent material and a flavourant (column 7, line 67 to column 8, line 11), the web material being positioned between said

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rod of smokable material and said wrapper. Gentry does not expressly disclose the web material extends over only a portion of the length of the rod of smokable material. Crooks discloses the inner paper can extend the entire length of tobacco rod or it may be shorter in length as a partial longitudinal paper (paragraph 19) that covers a section of the tobacco rod. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the smoking article of Gentry with a partial longitudinal inner wrapper that covers a section of the tobacco rod as taught by Crooks as an alternative.

Regarding claim 2, Gentry further discloses the smoking article comprising a filter element (70, fig. 1) containing an adsorbent material capable of reducing vapor phase components of smoke during smoking.

Regarding claim 3, Gentry discloses the web material is a cellulosic sheet material (Abstract).

Regarding claim 4, Gentry discloses the cellulosic sheet material is paper (column 2, lines 20-23).

Regarding claim 5, Gentry discloses the adsorbent material is incorporated within the web material as an integral component (column 7, line 67 to column 8, line 11).

Regarding claim 6, Gentry discloses the adsorbent material is a carbonaceous material (corresponding to the claimed activated carbon) for adsorbent flavors (column 7, line 67 to column 8, line 11)

Regarding claims 7-8, Gentry discloses adsorbent material can be in powder or particulate form and the loading level is about 10-30% by weight of the web material

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overlapping with the claimed range and therefore it would have been obvious to one of ordinary skill in the art to pick the claimed range (column 6, lines 12-25).

Regarding claim 9, Gentry discloses flavourant is menthol (column 8, lines 3-6).

Regarding claim 10, Crooks discloses the web material is adhered to an inner surface of said wrapper (paragraph 18).

Regarding claim 11, Crooks discloses the portion is at or towards the mouth end of said rod of smokable material (paragraph 19).

Regarding claim 12, Crooks discloses the portion is at or towards the lighting end of said rod of smokable material.

Regarding claim 13, the combination of Gentry and Crooks discloses the smoking article comprises two or more separate web materials, each web material containing an adsorbent and a flavorant (as discussed above for claim 1 and Crooks paragraph 18).

Regarding claim 14, Gentry discloses the web material is capable of comprise two different flavorants (column 8, lines 1-3).

Regarding claim 15, Gentry discloses the rod of smokable material comprises tobacco material having a flavourant applied thereto (column 4, lines 42-51).

Claims 16-17, 32-41 and 44-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tabuchi et al. (EP1421863 corresponding to WO 2003013284) in view of Crooks et al. (U.S. Pub. No. 20020185143)

Regarding claim 16, Tabuchi discloses a method of making a smoking article comprising feeding a web material, the web material comprising an adsorbent,

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transferring web sections onto a wrapper and circumscribing a rod of smokable material with said wrapper (paragraph 12 and fig. 4). Tabuchi discloses applying a flavor material on the web material and/or the wrapper (paragraph 12). Although, Tabuchi does not expressly disclose a cutting means for cutting web material into sections, it would have been obvious to one of ordinary skill in the art that the web material would need to be cut by a cutting means into an inner web for feeding to a forming section. Furthermore, it would have been obvious to one of ordinary skill in the art to modify the web material having a length which extends only over a portion of the length of said rod of smokeable material as taught by Crooks (paragraph 19).

Regarding claim 17, Tabuchi suggests the web material can be cut into sections having a length corresponding to twice the length of said web material in said smoking article (paragraphs 44-45).

Regarding claim 32, Tabuchi discloses an apparatus for making a smoking article comprising rolls (R1, R2 fig. 4) capable of supplying a web material containing an adsorbent and a flavovrant to a cutting means (by reference sign 38, fig. 1) capable of cutting the web material into sections, an assembly (see fig. 4) capable of transferring sections of web material onto a wrapper, adhering means (by reference sign 42, fig. 4) to bond the web material onto a wrapper, and a smoking article forming means (by reference sign 16, fig. 4). Although Tabuchi does not expressly disclose the means for supplying a web material comprising a mandrel, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have a mandrel to support the rolls for supplying a web material. Furthermore, it would have been obvious to one

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of ordinary skill in the art to modify the web material having a length which extends only over a portion of the length of said rod of smokeable material as taught by Crooks (paragraph 19)

Regarding claim 33, Tabuchi discloses the cutting means comprises a housing (36, fig. 4) having a knife (38, fig. 4) mounted thereon.

Regarding claim 34, Tabuchi discloses the knife is rotatable (paragraph 43) therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the housing rotatable with the knife.

Regarding claim 35, Tabuchi discloses the cutting means is in contact with the assembly for transferring sections of web material (see fig. 4).

Regarding claim 36, although Tabuchi discloses the assembly for transferring section is a drum but does not expressly disclose the type of the drum is a vacuum drum; however it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a vacuum drum for better suction of the material.

Regarding claim 37, Tabuchi discloses the adhering means comprises an adhesive applicator (42, fig. 4).

Regarding claim 38, it would have been obvious to one of ordinary skill in the art at the time the invention was made that the web material feeding means of Tabuchi is capable of being controlled to a desired speed for operation.

Regarding claim 39, Tabuchi discloses the feeding means is a roller (such as R1 and R2, fig. 4) but does not expressly disclose the type of the roller. However, it would

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have been obvious to one of ordinary skill in the art at the time the invention was made to choose a well known metering roller.

Regarding claim 40, Tabuchi suggests a tracking means for aligning the web material with the cutting mean (see by reference sign 38).

Regarding claim 41, Tabuchi discloses a heating means capable of heating the wrapper (paragraph 43).

Regarding claims 44-45, Tabuchi discloses a device (by reference sign 26, fig. 4 and roller connecting the wrapper and the web material equivalent to the claimed pinch roller) capable of applying pressure to the wrapper.

Claims 18-31 and 42-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tabuchi et al. (EP1421863 corresponding to WO 2003013284) in view of Crooks et al. (U.S. Pub. No. 20020185143).

Regarding claim 18, Tabuchi does not expressly disclose the method comprises said web material is cut into sections having a length less than the length of the rod of smokable material. Crooks discloses the inner web material can have a length less than that of the length of the rod of smokable material as an alternative (paragraph 19). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to cut the web material into sections with length less than that of the smokable material as taught by Crooks.

Regarding claim 19, Crooks discloses the web material is position at or to towards the mouth end of the smoking article (paragraph 19) therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to

modify the method of Tabuchi to transfer the web material onto the wrapper at or towards a position corresponding to the mouth end of the smoking article.

Regarding claims 20-21 and 23, Tabuchi discloses adhesive is applied to a surface of said web material before said web material so the web material is contacted and adhere to the wrapper (paragraph 48).

Regarding claim 22, Tabuchi does not expressly disclose the adhesive is applied in a strip, however this is just an obvious variant to apply adhesive to a surface that will be adhered to another surface.

Regarding claim 24, Tabuchi discloses wrapper is heated to bond the section of web material to said wrapper (paragraph 38).

Regarding claim 25, Tabuchi discloses a pressure is applied to said wrapper after said sections have been transferred onto said wrapper to adhere said web material to said wrapper (paragraph 41).

Regarding claims 26, Tabuchi suggests the wrapper is fed along a wrapper feed path to align with said section of web material (paragraph 12 and fig. 4).

Regarding claim 27, Tabuchi suggests the wrapper is guided along the wrapper feed path and contacts said sections of web material (paragraph 12 and fig. 4).

Regarding claim 28, Tabuchi discloses the sections are transferred by a drum assembly (fig. 4) but does not specify the type of drum. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a vacuum drum assembly for better grip of the sections.

Regarding claim 29, Tabuchi does not expressly disclose the speed of transferred of web material and wrapper; however it would have been obvious to one of ordinary skill in the art at the time the invention was made that the speed of web material and wrapper (as seen in fig. 4 of Tabuchi) are synchronized for operation.

Regarding claims 30 and 31, Crooks discloses the smoking article can have a plurality of web material (paragraph 18); therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to slit web material to form at least two web material feed paths and transfered them onto a single wrapper.

Regarding claims 42-43, Crooks discloses the smoking article can have a plurality of web material (paragraph 18), therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Tabuchi to have a slitting means to slit the web material to form at least two feed paths of web material corresponding two of cutting means, assembly for transferring means. Furthermore, although Tabuchi did not disclose a plurality of the above parts, mere duplication of parts has no patentable significance unless a new and unexpected result is produced (see *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960)).

### ***Response to Arguments***

Applicant's arguments filed 5/11/2010 have been fully considered but they are not persuasive.

Regarding claim 32, Applicant points out that there's a variety of "means for supplying a web material containing an adsorbent and a flavorant to a cutting means." in figures 6-9. However, the Applicant did not specifically point out the location of these

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means. If the Applicant believes there are other meanings to the means plus function language of claim 32, the Applicant is requested to point out the written description associated to the means plus function so the claim can be clearly understood.

Applicant essentially argues that there is no teaching, suggestion or motivation in Crooks et al. nor Gentry to provide flavourant in a strip which extends over only a portion of the length of the rod of smokeable material so as to provide the smoker with flavourant during only a selective portion of the article. However, the limitation of delivering flavourant to a smoker only during the smoking of a selective portion of the smoking article occurs in the preamble therefore, it has not been given patentable weight. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Also, it is recognized that the limitation of delivering flavourant to a smoker only during the smoking of a selective portion of the smoking article is a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Applicant further argues that neither Gentry nor Crooks has any contemplation or recognition of altering the delivery of flavourant in any way, and most particularly not in the manner used in the embodiments of Application's invention. However, this argument is toward the limitation that occurs in the preamble which has not been given patentable weight.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

The combination of Gentry and Crooks taken together as a whole teaches a rod of smokable material, a wrapper about said rod of smokable material and a web material comprising adsorbent material and a flavourant, the web material being positioned between said rod of smokable material and said wrapper (column 7, line 67 to column 8, line 11, and fig. 1 of Gentry), wherein said web material can extend over only a selective portion of the length of the rod of smokable material (paragraph 19 of Crooks).

Applicant also argues that the reference of Tabuchi has no teaching suggestion or motivation for using an apparatus or method as claimed for Applicant's embodiments

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because the inner wrapper extends the full length of the cigarette rod. However, as explained above, the reference of Crooks teaches the inner wrapper can extend the entire length or may be shorter in length as an alternative. Therefore, it would have been obvious to one of ordinary skill in the art to make the claimed wrapper shorter in length than that of the tobacco rod as taught by Crooks. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to PHU H. NGUYEN whose telephone number is (571)272-5931. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Phillip Tucker can be reached on 571-272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

P.N 7/16/2010

/Philip C Tucker/

Supervisory Patent Examiner, Art Unit 1791